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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,697	09/28/1999	SATOSHI ISHIGURO	35.C1387	1865

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NEW YORK, NY 10112

EXAMINER

SOBUTKA, PHILIP

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 03/22/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,697

Applicant(s)

ISHIGURO ET AL.

Examiner

Philip J. Sobutka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,7,8,19,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Parulski et al (US 5,666,159).

Consider claim 1. Parulski teaches an intake means (fig 9, item 64) for taking in images from an image pickup device (fig 9, item 68); communication means for transmitting the images to a transmission destination (fig 9, item 66); and control means for stating an operation of the communication means in response to the image pickup operation of the image pickup device (fig 9, item 62, col 5, lines 1-5).

As to claim 19, the apparatus of Parulski as shown above would perform the claimed steps.

As to claim 7, note that Parulski teaches a manipulative device ((capture switch fig 4, item 20) for starting the operation of the image pickup and hence the communication device.

As to claims 2,8,20, note that Parulski's transmission is via radio (see fig 9).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski.

Consider claim 13. Parulski teaches everything claimed as shown above except for the method being stored on a computer readable media. Official notice is taken that it is notoriously well known in the art to store methods of operation on computer readable media. It would have been obvious to one of ordinary skill in the art to modify Parulski to store the method on a computer readable media in order to allow the control method to be easily loaded onto another device.

As to claim 14, note that Parulski's transmission is via radio (see fig 9).

6. Claims 3,9,15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski in view of Boudreaux et al (5,909,648).

Consider claims 3,9, and 21. Parulski as applied to claims 1,7 and 19 teaches everything claimed as shown above except for the communication control breaking communications after a time period when the transmission of image data is completed. Boudreaux teaches a data transmission system in which a communication link is broken a predetermined time after data transmission is completed (Boudreaux see especially col 3, lines 20-60). It would have been obvious to one of ordinary skill in the art to modify Parulski to incorporate the break time as taught by Boudreaux in order to ensure that communication resources were not occupied unnecessarily.

Consider claim 15. Parulski as applied to claim 13 teaches everything claimed as shown above except for the communication control breaking communications after a time period when the transmission of image data is completed. Boudreaux teaches a data transmission system in which a communication link is broken a predetermined time after data transmission is completed (Boudreaux see especially col 3, lines 20-60). It would have been obvious to one of ordinary skill in the art to modify Parulski to incorporate the break time as taught by Boudreaux in order to ensure that communication resources were not occupied unnecessarily.

7. Claims 4-6,10-12,16-18, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski in view of Hull et al (5,806,005).

As to claims 4-6, 10-12, and 22-24, Parulski as applied to claims 1, 7 and 19 respectively, teaches everything claimed except a teaching of detecting the state of the communication and storing the image data if the state is incommunicative and transmitting when the communication is active. Hull teaches an image transfer system

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with a detection function that determines the state of the communication link and stores the data until the link is available when it is then transferred (Hull col 2, lines 38-62). It would have been obvious to one of ordinary skill in the art to modify Parulski to use the detection and storage function of Hull in order to ensure that data was not lost via a faulty communication link.

As to claims 16-18, Parulski as applied to claim 13 teaches everything claimed except a teaching of detecting the state of the communication and storing the image data if the state is incommunicative and transmitting when the communication is active. Hull teaches an image transfer system with a detection function that determines the state of the communication link and stores the data until the link is available when it is then transferred (Hull col 2, lines 38-62). It would have been obvious to one of ordinary skill in the art to modify Parulski to use the detection and storage function of Hull in order to ensure that data was not lost via a faulty communication link.

Specification

8. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 1, paragraphs 1 and 2, page 2, lines 3-8, page 4, lines 15-20, page 6, lines 15-20, etc.

Information Disclosure Statement

9. The information disclosure statement filed March 8, 2000 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

10. The information disclosure statement filed March 8, 2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant failed to provide a copy of all cited pending US patent applications as required by 37 CFR 1,98(a)(2)(iii), and because the US patent applications were not properly cited as required by 37 CFR 1,98(b)(3), cited below. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

See relevant passages cited below:

37 CFR § 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(2) A legible copy of:

- (i) Each U.S. patent application publication and U.S. and foreign patent;
- (ii) Each publication or that portion which caused it to be listed;
- (iii) *For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion;*

and

- (b)
 - (3) *Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.*

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Crane et al (US 5,533,097), Reece et al (US 5,893,037) and Wilkinson et al (US 6,122,521) have been cited to show relevant prior art arrangements for transmitting image data.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 703-305-4825. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Philip Sobutka

Pjs
March 11, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER